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09/918,074	07/30/2001	Jurgen Beil	534P008	2565

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Kevin S. Lemack
Nields & Lemack
Suite 8
176 E. Main Street
Westboro, MA 01581

4-2-04
J. Beil

Reply Brief
Due

EXAMINER

HAYES, BRET C

ART UNIT

PAPER NUMBER

3644

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT PAPER

18

DATE MAILED:

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Commissioner for Patents

Attached please find a properly signed and initialed copy of the Examiner's answer, Paper No. 14, filed May 23, 2003.

bh



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/918,074

Filing Date: July 30, 2001

Appellant(s): BEIL, JURGEN

Kevin S. Lemack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/12/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1 – 18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,887,376 Sibley et al. 12-1989

3,351,495 Larsen et al. 11-1967

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 – 18 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 11.

(11) Response to Argument

In response to Applicant's argument that Reinhardt et al is non-analogous art, it has been held that the determination that a reference is from a non-analogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174. In this case, the reference is within the field of the inventor's endeavor to produce aromatic and/or enticing articles, since perfume, which is an aromatic and/or enticing substance, can include a fish-luring substance.

Regarding *in re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986), in that case, the Applicant's claims related to double-acting high pressure gas transmission line compressors in which the valves could be removed easily for replacement. The Board relied upon references, which taught either a double-acting piston pump or a double-acting piston compressor. The court agreed that since the cited pumps and compressors have essentially the same function and structure, the field of endeavor includes both types of double-action piston devices for moving fluids. In this case, Reinhardt et al has the same function and structure as any of the base claims, since Reinhardt et al disclose a method for producing aromatic and/or articles and parts thereof.

comprising treating a material comprising porous, thermoplastic plastic with an aromatic and/or enticing substance.

Regarding the aqueous environment, in which Reinhardt et al is supposedly not intended to be used, even if Reinhardt et al expressly forbade the use of the invention in an aqueous environment, the argument would be moot because in the world of physics, an aqueous environment is interchangeable with a gaseous one, since both environments fall into the fluids category and as such the dynamics and physical laws involved are identical. This being the case, releasing perfume into the air is not very different from dispensing an aromatic and/or enticing substance into water to attract fish, as Applicant argues.

Examiner's reliance on Appellant's submission of Hozumi et al and Derrieu by way of an Information Disclosure Statement as indicative of the relevance of Reinhardt et al was only to demonstrate that other patent-related offices would also find state of the art material not exclusively within the fish-luring art. Further, the Examiner did not base any rejection of the claims on these disclosed references.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

An inventor is under no obligation to disclose how the invention works, and can, in fact, be entirely ignorant of how it works, so long as the invention is claimed clearly and concisely. That being the case, Reinhardt et al do not need to know about, or further, discuss the adsorption and controlled release of the perfume so long as the mechanism is in place. One of ordinary skill in the art at the time the invention was made would have the material at one's disposal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one of ordinary skill in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, the claims are directed to a thermoplastic plastic treated with a fish-luring aromatic and/or enticing substance. The only deficiency of Reinhardt et al in this regard is the fish-luring substance, which is what Sibley et al teach. Examiner is not combining the disclosure of Sibley et al with the teaching of Reinhardt et al, rather the disclosure of Reinhardt et al with teaching of Sibley et al to treat articles with fish-luring substances.

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Regarding the Larsen et al. reference is used only to support the rejection of the claimed creation of the polyolefin. Larsen et al teach the claimed limitations concerning the manufacturing of a thermoplastic plastic. One of ordinary skill in the art at the time the invention was made would have the teachings of Larsen et al at one's disposal for the purpose of creating a polyolefin, as set forth in Paper No. 11, paragraph 11.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

bch
December 3, 2003

Conferees
Charles T. Jordan *CTJ*
Robert P. Swiatek *RPS*

Charles T. Jordan
CHARLES T. JORDAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Kevin S. Lemack
Nields & Lemack
Suite 8
176 E. Main Street
Westboro, MA 01581